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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,567	07/31/2000	Li Wen Liu	A-69366/MAK/LM	4144
7590	07/29/2004		EXAMINER	
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400 Four Embarcadero Center San Francisco, CA 94111-4187			TRAIL, ALLYSON NEEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/628,567	LIU ET AL.
	Examiner	Art Unit
	Allyson N Trail	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 April 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 16-31 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) _____ is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 26 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/21/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed April 16, 2004.

Claim Objections

2. Claims 16-31 are objected to because of the following informalities:

Re the second claim numbered "16": replace "16" with --17--.

The remaining claims must as well be renumbered.

It is assumed by the Examiner that the claims referring to claim 16 are referring to the first claim 16. For clarity, the rejection is based on how the claims will be once renumbered.

Re claims 23 and 31, lines 1-2: "a biometric" is unclear. Perhaps replace with a biometric reader. Please clarify.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16-19, 24-27, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Harms et al (6,070,147).

Harms et al teaches the following in regards to claims 16-18 and 24-26:

Figure 1 shows a cashier-side unit 3 and a customer-response unit 15. A communication link 18 is also shown. Content for presentation at the customer-response unit during the transaction is received via the communication link. The ID card 16 is swiped through the customer-response unit and the customer ID is linked to a database, which is also linked to the register 3. Harms et al's invention is directed to a system for administering a loyalty marketing program (abstract). A customer is identified, and when appropriate, an award or reward is given. The rewards come in such forms as a discount or coupon. (Col. 1, lines 25-30). When a discount is given, the register must deduct from the total. Therefore in order to receive a discount, the register must be linked to the ID device. Furthermore, a monetary amount of the transaction is communicated from the cashier-side unit to the customer-response unit; and customer input is received at the customer-response unit. The customer-response unit includes a display (figure 1) where the monetary amount may be shown. The customer input includes the credit card, which may be read from the costumer-response unit. "the card reader 9 and the identification terminal 15 could be integrated into a single reader that is capable of reading both types of cards, or a single card that performs both functions." (Col. 5, lines 1-5). Lastly, the customer input and the monetary amount is transmitted to a remote service provider for authorization, "As is known in the art, when the card reader reads the credit card number, a remote database is accessed to verify the consumer's credit, and to log the charge on the consumer's account." (Col. 4, lines 34-37).

Regarding claim 25, the customer ID is not necessary for the transaction.

Harms et al teaches the following in regards to claims 19 and 27:

"Some of these terminals are capable of printing receipts of the transaction for store or customer use, or for record, audit, and other purposes." (Col. 4, lines 60-62).

Harms et al teaches the following in regards to claim 32:

"Whatever the composition of the network i/o circuitry, it is capable of communicating the received data to the computer 41. The computer 41 comprises local storage 43 and an i/o interface for communicating with various databases or files 47, 48, 49, and 50. As is well known in the art, the computer 41 executes a program stored on a data storage medium so as to carry out the functions of the present invention." (Col. 6, lines 58-65).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-23 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms et al (6,070,147) in view of Suer et al (6,431,439).

Harms et al's teachings are discussed above. Harms et al fails to specifically teach the customer input comprises an electronic signature, a PIN, and a biometric reader.

Suer et al teaches the following in regards to claims 21-23 and 29-31:

"As another example, the user may use the device 10 for a point-of-sale transaction. The user may wish to immediately transfer money between his account and a merchant's account. To implement a transaction, the user enters a PIN to access his account. Using the device 10, the user can transmit various key user information in order to start the transaction with the point-of-sale terminal 40 which may be connected to the user's bank as opposed to conventional systems which require writing and signing a check, swiping a card and entering a PIN number or providing cash in order to complete a financial transaction. The key user information may include the person's name, personal specifics, a transaction instrument, a lock step code, an encrypted PIN and digital signature, and possibly other biometrics information." (Col. 7, lines 1-15).

In view of Suer et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the customer input, an electronic signature, a PIN, and biometric information. The identification terminal 15, described by Harms et al may optionally allow the consumer (or retail clerk) to key-in additional data as prompted by the prompt queries displayed on the identification terminal 15 (see col. 5, lines 16-21). Harms et al's terminal is essentially already equipped to accept a PIN. One would be motivated to additionally accept electronic signatures and biometric information to ensure that the correct customer is receiving rewards and that the rewards are not being given to a fraudulent consumer.

7. Claims 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms et al (6,070,147) in view of WHITE (2002/0046082).

Harms et al's teachings are discussed above. Harms et al fails to specifically teach the customer content including an advertisement, coupon, or award.

WHITE teaches the following in regards to claims 20 and 28:

"Point-of-sale (POS) computer systems in stores have been supplemented with additional components to handle such functions as in-store printing of discount coupons and/or other purchasing incentives, reading and processing coupons brought to the store by customers, and reading other coded items at the point-of-sale, such as bank cards, customer loyalty cards, such as frequent shopper cards, credit cards, and checks, etc." (Page 1, paragraph 0015).

In view of WHITE's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the customer content include an advertisement, coupon, or award. Harms et al teaches that the customer ID acts somewhat as a coupon card by the fact that when the card is scanned, the customer is given discounts and credits. Additionally, Harms et al teaches issuing coupons to customers (see column 11, lines 22-35). One would be motivated to accept additional coupons at the customer-response unit in order for the customer to be able to scan the issued coupons to affect the total price of the purchase without the need to distract the cashier with the task of scanning additional coupons.

Response to Arguments

8. Applicant's arguments filed April 16, 2004 have been fully considered but they are not persuasive.

Applicant argues that Harms et al fails to teach receiving, via, the communications link of the customer-response unit, content for presentation at the customer-response unit during the transaction and that Harms et al also fails to teach the customer-response unit being coupled to the cashier-side unit. As stated above however, Harms et al's invention is directed to a system for administering a loyalty marketing program (abstract). A customer is identified, and when appropriate, an award or reward is given. The rewards come in such forms as a discount or coupon. (Col. 1, lines 25-30). When a discount is given, the register must deduct from the total. Therefore in order to receive a discount, the register must be linked to the ID device. It is also shown in figure 1 that the register is linked to the ID terminal.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schulze et al (2002/0055875).
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

Art Unit: 2876

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
July 20, 2004

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER